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| 09/942,606      | 08/31/2001  | Tetsuya Uemura       | 520.40551X00        | 7478             |

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EXAMINER

SHERKAT, AREZOO

ART UNIT PAPER NUMBER

2131

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/942,606 | <b>Applicant(s)</b><br>UEMURA, TETSUYA |  |
|                              | <b>Examiner</b><br>Arezoo Sherkat    | <b>Art Unit</b><br>2131                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5-11, 13-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-11, 13-15, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 19-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/10/05</u> | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/12/2005 has been entered.

***Allowable Subject Matter***

Claims 19-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5-7, 10, 13-15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by LeMole et al., (U.S. Patent No. 6,009,410 and LeMole hereinafter).

Regarding claims 5, 7, and 10, LeMole discloses an apparatus set between a server and a client for distributing contents to the client (i.e., the HTTP server and CAR server work as an intermediary between the client and the advertising sites, Col. 4, lines 10-34), comprising:

an apparatus for collecting contents access situation information from the client, and an apparatus for analyzing contents access trends based on the contents access situation information (Col., 5, lines 23-51);

an apparatus for transmitting the contents access trends to a server which predicts contents expected to be in demand in the future based on the contents access trends and transmits the contents (Col. 5, lines 1-22); and

an apparatus for receiving the contents expected to be in demand in the future from the server in advance before an access request is received from the client, and apparatus for storing the received content (i.e., CAR server dynamically configures a customized advertising page for the user which is stored in database 112 in form of an electronic profile for each registered user. Such a profile indicates subject areas of interest of each user and a user's demographic data from which information a plurality of images, banners, video clips, sound clips, etc. from different advertisers are combined by CAR server 111 into an aggregated advertising page or pages with hyperlinks to the advertising sites of each of the combined advertisers. Such a profile of interests and demographic data is provided by the user on-line when the user registers to have access to the customized advertising repository service - registration is done before any access request is made)(Col. 4, lines 36-59); and

an apparatus for transmitting the contents to the client in accordance with the request when received from the client (Col. 6, lines 46-67 and Col. 7, lines 1-5).

Regarding claims 6 and 15, LeMole discloses an apparatus for distributing contents to a client, comprising:

an apparatus for transmitting the contents access situation information to the server which transmits a list of the contents predicted, an apparatus for receiving the list of the contents from the server, and an apparatus for acquiring the contents based on the list of the contents (i.e., by providing information relating to the Web sites visited by the user during the work context mode prior to entering the commercial context mode, at least some of the composite images, video and audio clips, and etc. in the dynamically configured advertising page presented to the user upon entering the commercial mode can be associated with advertisers which have a nexus with the user(s) previously visited Web site(s))(Col. 5, lines 1-67 and Col. 6, lines 1-20).

Regarding claims 14 and 18, LeMole discloses wherein this apparatus distributes the contents to the client only when distribution of the contents to the client is permitted (Col. 4, lines 1-67 and Col. 5, lines 1-67 and Col. 6, lines 1-45).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole et al., (U.S. Patent No. 6,009,410 and LeMole hereinafter), in view of Alegre et al., (U.S. Patent No. 6,199,113 and Alegre hereinafter).

Regarding claim 8, LeMole discloses an apparatus set between a server and a client for distributing contents to the client (i.e., the HTTP server and CAR server work as an intermediary between the client and the advertising sites, Col. 4, lines 10-34), comprising:

- an apparatus for collecting contents access situation information from the client, and an apparatus for analyzing contents access trends based on the contents access situation information (Col., 5, lines 23-51);

- an apparatus for transmitting the contents access trends to a server which predicts contents expected to be in demand in the future based on the contents access trends and transmits the contents (Col. 5, lines 1-22); and

- an apparatus for receiving the contents expected to be in demand in the future from the server in advance before an access request is received from the client, and apparatus for storing the received content (i.e., CAR server dynamically configures a customized advertising page for the user which is stored in database 112 in form of an electronic profile for each registered user. Such a profile indicates subject areas of interest of each user and a user's demographic data from which information a plurality

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of images, banners, video clips, sound clips, etc. from different advertisers are combined by CAR server 111 into an aggregated advertising page or pages with hyperlinks to the advertising sites of each of the combined advertisers. Such a profile of interests and demographic data is provided by the user on-line when the user registers to have access to the customized advertising repository service - registration is done before any access request is made)(Col. 4, lines 36-59); and

an apparatus for storing a database for recording information for distinguishing a client and recording permission information concerning distribution of contents to the client (i.e., CAR server 111), and a database for recording information for distinguishing a client and recording permission information concerning distribution of contents to the client (i.e., database 112) , a database access apparatus (Col. 4, lines 4-35);

an authentication apparatus for authenticating the client and acquiring the information for distinguishing the client (i.e., HTTP server 110) (Col. 4, lines 4-35);

an apparatus for receiving the permission information concerning distribution of contents to the client from a server which manages distribution permission information, an apparatus for requesting acquisition of permission to distribute the contents from the server to the client (i.e., HTTP server 110 recognizes the user either through the input of an ID by the user or through a cookie previously provided to the user's browser by server 110 in a previous interaction)(Col. 4, lines 4-59); and

an apparatus for transmitting the contents to the client in accordance with the request when received from the client (i.e., registration takes place before the user

may access a full Web page by clicking on an ad in the composite page)(Col. 7, lines 5-35), wherein:

the client distinguishing information is acquired by the authentication apparatus when contents distribution request is received from the client (Col. 4, lines 4-34).

LeMole does not expressly disclose permission information concerning distribution of contents to the clients.

However, Alegre discloses wherein the distribution permission information of the contents (i.e., user access profile) is checked for the client distinguishing information by the database access apparatus (Col. 5, lines 20-47), the contents are distributed to the client when the distribution is permitted (Col. 7, lines 1-18),

a request is made to acquire permission to distribute the contents from the server to the client by the apparatus for requesting acquisition of permission when the distribution is not permitted (Col. 5, lines 59-67 and Col. 6, lines 1-5), and

the permission information concerning distribution of contents to the client is written by the database access apparatus onto the database for recording permission information, and the contents are distributed to the client when the apparatus for receiving the permission information (i.e., user access profile) receives permission to distribute the contents to the client from the server (Col. 4, lines 24-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify LeMole's method and system of customized advertising by including permission information concerning distribution of contents to the clients as disclosed by Alegre. This modification would have been obvious because



one of ordinary skill in the art would have been motivated by the suggestion of Alegre to provide a higher level of security for trusted network in order to allow access by users on the Internet in a controlled and secured manner (Alegre, Col. 2, lines 24-35).

Regarding claim 9, LeMole discloses distributing contents to the previously registered (i.e., authorized) user based on her surfing habits or interests (Col., 5, lines 23-51).

LeMole does not expressly disclose permission information concerning distribution of contents to the clients.

However, Alegre discloses when distribution of the contents to the client is not permitted, the apparatus for receiving the permission information receives the distribution permission, and the database access apparatus writes the permission information onto the permission information concerning the distribution of the contents in the database (Col. 4, lines 24-67).

LeMole does not expressly disclose an encryption key to encrypt and/or decrypt the content for distribution.

However, Alegre discloses wherein: the contents are encrypted and an entry which registers the decryption key of the contents exists in the database, and the server manages the decryption key, the apparatus further comprises: an apparatus for requesting the decryption key from the server; an apparatus for receiving the decryption key from the server which manages the decryption key (Col. 4, lines 8-67 and Col. 5, lines 1-20); and

an apparatus for distributing the decryption key to the client,  
wherein: when distribution of the contents to the client is permitted and the decryption key is registered in the database, the decryption key is distributed to the client by the apparatus for distributing the decryption key (Col. 6, lines 23-50),

when distribution of the contents to the client is permitted and the decryption key is not registered in the database, the decryption key is requested from the server by the apparatus for requesting the decryption key, received by the apparatus for receiving the decryption key, registered in the database by the database access apparatus, and distributed to the client by the apparatus for distributing the decryption key (Col. 6, lines 50-67), and

the decryption key is requested from the server by the apparatus for requesting the decryption key, received from the server by the apparatus for receiving the decryption key, and distributed to the client by the apparatus for distributing the decryption key (Col. 6, lines 23-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify LeMole's method and system of customized advertising by including permission information concerning distribution of contents to the clients and an encryption key to encrypt and/or decrypt the content for distribution as disclosed by Alegre. This modification would have been obvious because one of ordinary skill in the art would have been motivated by the suggestion of Alegre to provide a higher level of security for trusted network in order to allow access by users

on the Internet in a controlled and secured manner (Alegre, Col. 2, lines 24-35) and to prevent an intruder from monitoring communications (Alegre, Col. 1, lines 13-55).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole et al., (U.S. Patent No. 6,009,410 and LeMole hereinafter), in view of Dragulev et al., (U.S. Publication No. 2001/0037407 and Dragulev hereinafter).

Teachings of LeMole with respect to claim 5 have been discussed previously.

Regarding claim 11, LeMole does not expressly disclose an apparatus for determining a deletion timing of the contents acquired using the contents access situation information.

However, Dragulev discloses an apparatus for determining a deletion timing of the contents acquired using the contents access situation information (Pages 5-6, Par. 0099-0100).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify LeMole's method and system of customized advertising by including an apparatus for determining a deletion timing of the contents acquired using the contents access situation information as disclosed by Dragulev. This modification would have been obvious because one of ordinary skill in the art would have been motivated by the suggestion of Dragulev to enable the users to use

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any network enabled information device with their personalized configuration parameters and application settings (Dragulev, Page 2-3, Par. 0032).

Claims 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMole et al., (U.S. Patent No. 6,009,410 and LeMole hereinafter), in view of Miller et al., (U.S. Patent No. 5,920,701 and Miller hereinafter).

Teachings of LeMole with respect to claims 5 and 7 have been discussed previously.

Regarding claims 13 and 17, LeMole does not expressly disclose receiving the contents from the server in a time zone when there is sufficient network bandwidth.

However, Miller discloses receiving the contents from the server in a time zone when there is sufficient network bandwidth (Col. 7, lines 49-67 and Col. 8, lines 1-17).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify LeMole's method and system of customized advertising by including receiving the contents from the server in a time zone when there is sufficient network bandwidth as disclosed by Miller. This modification would have been obvious because one of ordinary skill in the art would have been motivated by the suggestion of Miller to coordinate the transfer of data to replicated sites from multiple content sources such that network resources are optimally utilized (Miller, Col. 1, lines 50-55).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arezoo Sherkat whose telephone number is (571) 272-3796. The examiner can normally be reached on 8:00-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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